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Docket No. 74508XNAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:)	Group Art Unit: 2612
David KESSLER et al.)	
Serial No. 08/770,381)	Examiner: J. Wilson
Filed: October 25, 1999)	
For: ANTI-ALIASING LOW-PASS)	Date: November 17, 2003
BLUR FILTER FOR REDUCING)	
ARTIFACTS IN IMAGING)	
APPARATUS)	Appeal No. 2002-0621
)	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to: Mail Stop BPAI, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, or being facsimile transmitted to the USPTO at (703) , on November 20 2003.

Tara M. Piccone
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REQUEST FOR REHEARING
UNDER 37 C.F.R. 1.197(b)

Mail Stop BPAI
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Board of Patent Appeals and Interferences' *Decision on Appeal* of September 26, 2003, the Appellants respectfully request reconsideration, under 37 C.F.R. 1.197(b), for the reasons set forth below.

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REMARKS

In the *Decision on Appeal*, it is noted that the BPAI did not consider the Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131) filed July 3, 2000 due to the failure to comply with several formal requirements for submission of a proper declaration under Rule § 1.131. Specifically, the *Decision on Appeal* noted that the Declaration, under § 1.131, was signed only by David Kessler rather than each of the inventors David Kessler, Allan Nutt and Russell Palum, as is required by MPEP Chapter 715.04. The failure to have the each inventor sign the Declaration of July 3, 2000 was an error without deceptive intent by the Appellants in understanding the requirement of 37 C.F.R. § 1.131(a):

"the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based."

to mistakenly mean that an inventor of the claimed subject matter may prepare an oath or declaration. Further, since each piece of evidence submitted with the Declaration of July 3, 2000 was developed by Mr. Kessler, it was thought that Mr. Kessler was most qualified to submit the Declaration under § 1.131. In order to remedy the deficiency noted by the Decision on Appeal, the Appellants hereby submit a Declaration under § 1.131 properly executed by each of the inventors. Acceptance and consideration, under 37 C.F.R. 1.195, of the attached, updated and properly executed "Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131)" is respectfully requested.

In addition to the failure to have all inventors properly sign the Declaration, under § 1.131, of July 3, 2000, the *Decision on Appeal* noted that the first piece of evidence filed with the Declaration was not present in the Application file. That is, it appears that the submission of the "photocopy of David Kessler's personal log marking August 3, 1995 as the day of invention" referenced in the Declaration has

been lost or misplaced after consideration of the Declaration by the Examiner in preparation of the *Examiner's Answer* of February 28, 2001. This is evident since the Examiner, in the *Examiner's Answer*, makes no mention of the "photocopy of David Kessler's personal log marking August 3, 1995" as being missing in that portion of the *Examiner's Answer* discussing the Declaration, and further states, in the *Examiner's Answer*, that the evidence which predates the filing date of the Fukushima patents is "insufficient to establish a conception of the invention prior to the effective date of the reference." Since the copy of the personal log page of David Kessler appears to have been lost or misplaced, please find attached to the enclosed properly signed "Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131)" another copy of the missing log page of Mr. Kessler. Acceptance and consideration of the photocopy of the David Kessler's personal log page of August 3, 1995 is respectfully requested.

Turning to the Examiner's statements regarding the showings of the "Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131)" as being insufficient to establish conception of the invention prior to the effective filing date of the Fukushima (U.S. Patent 5,579,420) and the Fukushima et al. (U.S. Patent 5,646,399) references, i.e. prior to February 7, 1996 and January 29, 1996, respectively, the Appellants again assert that the attached Declaration, under § 1.131, clearly establishes that the Appellants had possession of the invention as set forth in the instant claim 1 prior to January 29, 1996. Specifically, claim 1 sets forth the following features:

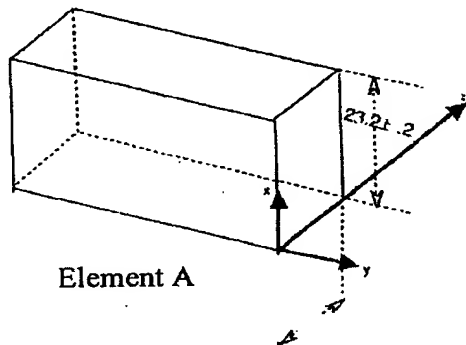
An imaging apparatus for generating an image signal from incident light...comprising:

an image sensor for generating the image signal from an array of photosites;

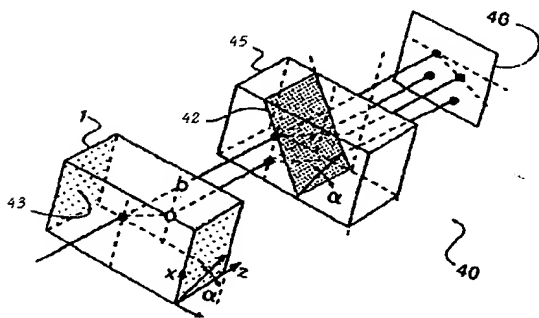
an optical section having a birefringent uniaxial crystal spatial filter...said birefringent uniaxial crystal spatial filter birefringence being greater than 0.05, and ...being lithium niobate; and

wherein said spatial filter of a first plane plate and at least a second plane plate of lithium niobate. (Emphasis Added)

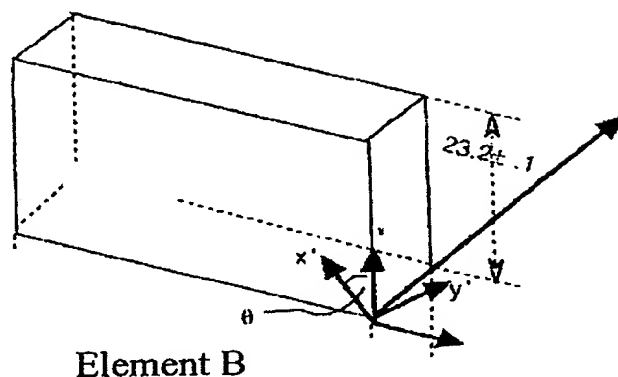
A review of the David Kessler's personal log page of August 3, 1995, clearly indicates that the invention is the use of lithium niobate crystals as blur filters (in a camera). As noted in the instant specification, at pages 1 and 2, it is well known to use a birefringent blur filter between the lens and image sensor array in cameras to overcome the aliasing or artifact problems occurring when capturing the image of an object having fine details. Shortly, after recording the invention in the personal log page of August 3, 1995, Mr. Kessler contacted Mr. Mizell at Virgo Optics and subsequently prepared Purchase Requisition No. 88240, on August 31, 1995, which ordered two sets (Items A and B) of lithium niobate prisms from Virgo Optics utilizing drawings attached thereto. A prism from the first set (Item A) of lithium niobate prisms is shown below:



which is the same structure as the prism 43 illustrated in Figure 4 (below) of the present invention and which is referred to in the personal log page of August 3, 1995:



Additionally, a prism from the second set (Item B) of lithium niobate prisms is shown below:



which is the same structure as the prism 42 illustrated in Figure 4 (above) of the present invention and which is also referred to in the personal log page of Mr. Kessler. Further, note that the Declaration establishes, via the Virgo Optics Shipping Packlist of September 11, 1995, that the eight prisms ordered with Purchase Requisition No. 88240 were shipped Airborne Express on September 29, 1995 to the inventors at Eastman Kodak. From the above facts which are set forth in the Declaration and supporting documentary evidence, it is clear that the Appellants conceived of the invention set forth in claim 1 (lithium niobate blur filters) before the filing date of the Fukushima references.

The Examiner's statement in the Examiner's Answer that, with regard to the evidence documents submitted with the Declaration under § 1.131, "only the predated documents are relevant for argument" is not understood since the MPEP Chapter 715.07 clearly states that there are three ways to show prior invention via filing of a Rule § 1.131 declaration:

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just

prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909). (Emphasis Added)

Therefore, the Examiner's failure to consider the documentary evidence submitted having dates which do not pre-date the filing date of the Fukushima ('420) reference is inappropriate since each evidentiary document attached to the Declaration, under § 1.131, having a date after the filing date of Fukushima ('420) is for the purpose of establishing diligence up to the actual reduction to practice which is evidenced by the Kodak Invention Disclosure of August 27, 1996.

The Appellants assert that upon consideration of the newly signed Declaration of Prior Invention in the United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication (37 C.F.R. § 1.131) along with the documentary evidence attached thereto, it is clear that the inventors conceived of the present invention of claim 1 prior to the January 29, 1996 filing date of the Fukushima et al. patent (as well as the Fukushima ('420) patent) and further that the inventors have shown diligence in reducing the invention to practice after the filing date of the Fukushima et al reference. Consequently, since the Fukushima patents are no longer

prior art to the instant claims, the rejections of claims 1, 4, 5, 10-12, 15, 17 and 18, under 35 U.S.C. 103(a), based upon the teachings of Greivenkamp, Jr. (U.S. Patent 4, 575,193) and either the Fukushima ('420) or Fukushima et al patents are no longer proper since each feature of the claimed invention is not taught or suggested by the Greivenkamp, Jr. reference alone. Each of the rejections of record must therefore be reversed and the claims indicated as allowable.

Respectfully submitted,



By: _____

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